

U.S. Patent Appln. No. 10/086,391
Amendment Dated Nov. 25, 2005
Reply to Office Action of Aug. 25, 2005
Docket No. BOC9-2001-0012 (247)

REMARKS/ARGUMENTS

These remarks are made in response to the Final Office Action of August 25, 2005 (Office Action). As this response is timely filed within the three-month shortened statutory period, no fee is believed due.

In the Office Action, Claims 1, 5-11, 13, 14, 16, 19, 20, 22 and 23 were rejected under 35 U.S.C. § 103(a) as being anticipated by U.S. Patent No. 6,026,156 to Epler, *et al.* (hereinafter Epler) in view of U.S. Patent No. 6,636,506 to Fan (hereinafter Fan) and in further view of U.S. Published Patent Application No. 2003/0023759 to Littleton, *et al.* (hereinafter Littleton). Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of Fan and further in view of Littleton as well as U.S. Patent No. 5,559,860 to Mizikovsky (hereinafter Mizikovsky). Claims 12, 15, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Epler in view of Fan and Littleton, and further in view of U.S. Patent No. 6,108,630 to Kuechler *et al.* (hereinafter Kuechler) and U.S. Patent No. 5,930,501 to Neil (hereinafter Neil).

With respect to independent Claims 1, 7, 14, and 20, more particularly, it is stated at page 3 of the Office Action that Epler "inherently" associates distinctive tones with respective calling parties as recited in each of the claims. Specifically, it is asserted that, because a user edits Voice-over-IP (VIP) code to effect a call number screening list, "distinctive tones are based on [a] caller's CPID [calling party identification]."

Applicants respectfully assert, however, that Epler in fact does not suggest, inherently or otherwise, the association of distinctive tones with different calling parties as recited in the independent claims. More fundamentally, the explicit language of Epler shows that distinctive tones are not based on the caller's CPID but whether the call is urgent or not.

The screening list created by the user associates an Automatic Number Identification (ANI), stored in the database of Epler's Enhanced Call Waiting System, with the caller's CPID. (See, e.g., Col 6, lines 38-48; Bob is the person called, and it is

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determined whether a call is forwarded when Bob is busy and whether Bob's number is stored in the database.) When a party called is already on the line, the call is forwarded to the Enhanced Call Waiting System if the party's ANI is stored in the database. (Col. 6, 40-42.)

When a party's ANI is recognized as stored in the database, the calling party is informed whether or not the called party's phone is busy. (Col. 6, lines 43-48.) If so, then the calling party hears a recording informing the calling party that the called party's phone is busy. The calling party is also offered the opportunity to use a touch-tone key pad (e.g. "press 1") to indicate the call is urgent. If so and if the calling party so indicates, then the called party "hears a prompt (usually a tone or beep) indicating that a call is waiting." (Col. 5, lines 55-61.) (emphasis supplied.) There is not even a remote suggestion, however, that one tone or beep is different from any other. Certainly, there is not the remotest suggestion that a different tone is associated with a particular calling party, as recited in each of independent Claims 1, 7, 14, and 20.

Epler accordingly does not identify different calling parties. Only if the ANI is stored in the system disclosed by Epler, is a calling party informed when the called party is busy and offered the opportunity to break-in to the call. This is done not by sending a tone or beep – not different tones – to the called party. The only indication received by the called party is a tone or beep that serves as an indication that the particular *call is urgent*. No where in Epler is there the suggestion that different parties are identified by distinctive tones: "the user who is engaged . . . will hear a distinctive call waiting tone which indicates the level of urgency or importance identified by the caller directly or the caller's CPID." (Col. 6, lines 14-21.) Knowing that a call is urgent, however, does not identify who the caller is. This is because there is only one tone or beep – that which indicates whether the call is urgent – not distinctive tones associated or assigned to different callers, as recited in the independent claims. None of the other references supply this feature.

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Applicants respectfully assert that whereas the references, alone and in combination, fail to teach or suggest every feature found in independent Claims 1, 7, 14, and 20, the claims define over the prior art. Applicants further respectfully assert that whereas the remaining claims each depend from one of the independent claims while reciting additional features, the dependent claims likewise define over the prior art.

CONCLUSION

Applicants believe the application to be in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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